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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,474	09/08/1998	EIJI TAKASU		3424

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/148,474	TAKASU ET AL.
	Examiner	**Art Unit**	
	CESAR B PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2002* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5)☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to the amendment filed on 11/20/2002.

This action is made Final.

2.   In the amendment, claims 1-31 are pending in the case. Claims 1, 10, 14, 26, and 30-31

are independent claims.

3.   The rejections of claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over Mosher

in view of Forcier (Pat. # 5,590,257, 12/31/96), further in view of Linking Handwriting

Annotation with Text, IBM TDB, vol.32, No.6A, pp.452-454, 11/1989 have been withdrawn as

necessitated by the amendment.

Priority

4.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d), and based on application # 9-243,991 filed in Japan on 9/9/1997, which

papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher view

of Linking Handwriting Annotation with Text, IBM TDB, vol.32, No.6A, pp.452-454, 11/1989,

and further in view of Forcier (Pat. # 5,590,257, 12/31/96).

Regarding independent claim 1, Mosher discloses: *storing a received mail document --*

"You can save messages ......" (p.1). Mosher fails to explicitly teach *ink data overlaid on a text*

image...a reproduction position of the ink image being defined by a coordinate value on

reference coordinate axes of the received mail document. However, IBM teaches the overlaying

of ink over text data (p.1, and fig.1). Forcier teaches the definition, or identification of ink image

text in terms of relative, and actual X, Y, document coordinates (c.21,L.31-67). It would have

been obvious to one of ordinary skill in the art at the time of the invention to have combined the

email system of Mosher, the overlaying of ink data and text data of IBM, and Forcier, because

IBM teaches preserving the correspondence between text and ink annotation (p.1,L.10-14), and

Forcier teaches above the anchoring of ink data.

Moreover, Mosher discloses: inserting a character string to email text data when a new

email is prepared --"Figure 12.9 When you reply to a message....indenting the message text and

including header " (p.4, and 7). Mosher fails to explicitly teach *calculating a shift amount of an*

the reproduction position of the ink image..... and outputting, as the new document, the ink image

which is overlaid on the new text image ...the ink image being shifted according to the calculated

shift amount. However, IBM teaches the moving text and handwritten together by a

predetermined shift amount (p.1, lines 10-29). Forcier teaches pushing or shifting down of data,

consisting of text/ink image, based on the input of preceding document data (c.10,L.35-

c.11,L.67). It would have been obvious to one of ordinary skill in the art at the time of the

invention to have combined the email system of Mosher, the overlaying of ink data and text data

of IBM, and Forcier, because IBM teaches preserving the correspondence between text and ink

annotation (p.1,L.10-14), and Forcier teaches above ensuring that data stays together.

Regarding claim 2, which depends on claim 1, Mosher discloses: "Figure 12.9 When you

reply to a message....indenting the message text and including header " (p.4). Mosher fails to

explicitly teach *the ink data comprises locus information to define the output position by*

coordinate values. However, IBM teaches the moving text and handwritten together by a

predetermined shift amount (p.1, lines 10-29). It would have been obvious to one of ordinary

skill in the art at the time of the invention to have combined shifting of email messages by

Mosher, and the locus information of ink/ASCII editing system by moving/shifting **(locus x-y**

placement of ink data), and maintaining the pre-existing word spacing in the characters as

taught by IBM, because IBM teaches preserving the correspondence between text and ink

annotation (p.1,L.10-14).

Regarding claim 3, which depends on claim 1, Mosher discloses: "...how much text of

the incoming message to quote ......" (p.3). Mosher fails to explicitly disclose: ....*said character*

string to be inserted is a quotation symbol. However, it would have been obvious to a person of

ordinary skill in the art at the time of the invention to have included the quotation symbol,

because Mosher teaches above, quoting text in a reply email message.

Regarding claim 4, which depends on claim 1, Mosher discloses: "...how much text of

the incoming message to quote" (p.3). Mosher fails to explicitly teach *said character string to be*

inserted is an inserting comment text. However, Forcier teaches: "performing word editing

functions such as word wrap while maintaining the user's word spacing", and "Typical users of

the invention would be people who want to jot down notes with/without drawings" (col. 3, lines

3-67, and col. 5, lines 27-67). It would have been obvious to one of ordinary skill in the art at

the time of the invention to have combined shifting of email messages by Mosher, and the jotting

notes with ink/ASCII editing system to maintain word spacing taught by Forcier, because Forcier

teaches above the entering of data into a textual document without having to perform explicit

actions to acquire additional blank spaces, and quickly annotating a document.

Claims 5-9 are directed towards a method for implementing the steps found in claim 1, 1,

6, and are similarly rejected.

Claims 10-11 are directed towards a method for implementing the steps found in claims

1-2, and 1 respectively, and are similarly rejected.

Claims 12-15, 17-22 are directed towards an information processing apparatus for

implementing the steps found in claims (1-2), 2, and 1-2, and 4-9 respectively, and are similarly

rejected.

Claim 16 is directed towards an information processing apparatus for implementing the

steps found in claim 3, and is similarly rejected.

Regarding claim 23, which depends on claim 14, Mosher discloses: *output means is an*

inkjet printer-- (p.9). Mosher teaches use of a print file icon to print the email in a printer such

as an inkjet printer.

Claims 24-29 are directed towards an information processing apparatus for implementing

the steps found in claims 23, 1, 10-13 respectively, and are similarly rejected.

Claims 30-31 are directed towards a storage medium for storing instructions for

implementing the steps found in claims 1, and 10 respectively, and are similarly rejected.

Response to Arguments

7.   Applicant's arguments filed 11/20/02 have been fully considered but they are not

persuasive. The Applicants submit that the applied art does not disclose or suggest the

calculation of a shift amount as well as an output image according to the calculated amount

(p.11, L. 1-20). The Applicants are directed towards the newly crafted rejections above as

necessitated by this amendment.

Conclusion

8.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

      A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

I.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Forcier (Pat. # 6,487,570).

II.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The

examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

(EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at

least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

> Director United States Patent and Trademark Office
>
> Washington, D.C. 20231

>   Or faxed to:

o   **(703) 746-7238, (for After Final** communications intended for entry)

o   **(703) 746-7239, (for Formal** communications intended for entry, **except formal After Final**

communications)

>   Or:

o   **(703) 746-7240, (for Informal or Draft** communications for discussion only, please label

"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Arlington, VA, Sixth Floor (Receptionist).

CBP

1/16/03